



UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS TX 75202

MAILED

AUG 27 2010

OFFICE OF PETITIONS

Paper No. 23

RECEIVED

OCT 06 2010

OFFICE OF PETITIONS

In re Patent No. 5,748,740
Issue Date: May 5, 1998
Application No. 08/594,983
Filed: January 31, 1996
Attorney Docket No. 20661/457

ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed July 12, 2010, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is DISMISSED.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of \$400 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, the Commissioner will undertake no further reconsideration or review of the matter.

The patent issued May 5, 1998. The first (3 1/2 year) maintenance fee was due May 5, 2002, and could have been paid from May 5, 2001 through November 5, 2001, or with a surcharge during the period from November 6, 2001 through May 5, 2002. Accordingly, the patent expired at midnight May 5, 2002, for failure to timely submit the first maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1), (2), and (3) above.

Petitioner asserts that the now disbanded firm of Jenkins & Gilchrist was the person responsible for payment of the maintenance fee due.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. *Id.*

As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). *Id.* Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. *Id.* Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. *Id.*

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

Petitioner asserts that the now disbanded firm of Jenkins & Gilchrist was responsible for payment of the maintenance fee. Therefore, petitioner must provide a statement from the responsible party at Jenkins & Gilchrist showing: (1) the steps that were in place to ensure timely payment of the maintenance fee, (2) a complete explanation of how the system worked, (3) an explanation as to why the system failed in this instance, and (4) a documented showing that Jenkins & Gilchrist was in fact obligated to track the fee on behalf of petitioner. Petitioner is advised, however, that the USPTO is not the forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. *See Ray*, 55 F. 3d at 610, 34 USPQ2d at 1789.

The showing or record is that petitioner was aware or should have been aware that the maintenance fee was due. Why was it reasonable and prudent for petitioner to rely on Jenkins & Gilchrist for timely payment of the maintenance fee? Why was it unavoidable for petitioner to check whether the maintenance fee had been paid and, if the fee had not been paid, pay the fee?

Furthermore, petitioner has not submitted the required maintenance fees for the first (3 ½ year) and second (7 ½ year) maintenance fees (\$930 and \$2,300, respectively) nor have they submitted payment of the surcharge of \$700 set forth in 37 CFR 1.20(i)(1)

Petitioner will not receive future correspondence related to maintenance fees for the above identified patent unless a "fee address" (see PTO/SB/47) is submitted for the above-identified patent. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.


Further correspondence with respect to this matter should be addressed as follows:

By Mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By Hand: U. S. Patent and Trademark Office
 Customer Service Window, Mail Stop Petitions
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

The centralized facsimile number is (571) 273-8300.

Telephone inquiries should be directed to the April M. Wise at (571) 272-1642.



David Bucci
Petitions Examiner
Office of Petitions

Cc: NORTH WEBER & BAUGH LLP
2479 E. BAYSHORE RD., STE 707
PALO ALTO, CA 94303
